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 20 MICROSOFT CORPORATION

21 UNITED STATES DISTRICT COURT  
 22 NORTHERN DISTRICT OF CALIFORNIA  
 23 OAKLAND DIVISION

24 INTERTRUST TECHNOLOGIES  
 25 CORPORATION, a Delaware corporation,

26 Plaintiff,

27 v.

28 MICROSOFT CORPORATION, a  
 Washington Corporation,

Defendant.

CASE NO: C 01-1640 SBA

**MICROSOFT CORPORATION'S  
 FIRST AMENDED ANSWER AND  
 COUNTERCLAIMS TO THE SECOND  
 AMENDED COMPLAINT**

Defendant Microsoft Corporation ("Microsoft") answers the Second Amended Complaint of InterTrust Technologies Corporation ("InterTrust") as follows:

1. Microsoft admits that the Second Amended Complaint purports to state a cause of action under the patent laws of the United States, 35 United States Code, §§ 271 and

281. Microsoft denies that it has infringed or now infringes the patents asserted against Microsoft

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MICROSOFT CORPORATION'S FIRST AMENDED ANSWER  
 AND COUNTERCLAIMS. CASE No. C 01-1640 SBA

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1 in the Second Amended Complaint. Microsoft denies any and all remaining allegations of  
2 paragraph 1 of the Second Amended Complaint.

3 2. Microsoft admits that the Second Amended Complaint purports to state a  
4 cause of action over which this Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and  
5 1338(a).

6 3. Microsoft admits, for purposes of this action only, that venue is proper in  
7 this judicial district. Microsoft denies any and all remaining allegations of paragraph 3 of the  
8 Second Amended Complaint.

9 4. Upon information and belief, Microsoft admits the allegations of paragraph  
10 4 of the Second Amended Complaint.

11 5. Microsoft admits the allegations of paragraph 5 of the Second Amended  
12 Complaint.

13 6. Microsoft admits, for purposes of this action only, that it transacts business  
14 in this judicial district. Microsoft denies any and all remaining allegations of paragraph 6 of the  
15 Second Amended Complaint.

16 7. Microsoft admits that on its face the title page of U.S. Patent No. 6,185,683  
17 B1 ("the '683 Patent") states that it was issued February 6, 2001, is entitled "Trusted and secure  
18 techniques, systems and methods for item delivery and execution," and lists "InterTrust  
19 Technologies Corp." as the assignee. Microsoft admits that a copy of the '683 Patent was  
20 attached to the copy of the Second Amended Complaint delivered to counsel for Microsoft, but  
21 denies that such copy was full and complete insofar as it did not include any material purportedly  
22 incorporated by reference therein. Microsoft denies that the '683 Patent was duly and lawfully  
23 issued. Microsoft further denies any and all remaining allegations of paragraph 7 of the Second  
24 Amended Complaint.

25 8. Microsoft admits that on its face the title page of U.S. Patent No. 6,253,193  
26 B1 ("the '193 Patent") states that it was issued June 26, 2001, is entitled "Systems and methods  
27 for the secure transaction management and electronic rights protection," and lists "InterTrust  
28 Technologies Corporation" as the assignee. Microsoft admits that a copy of text associated with

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1 the '193 Patent was attached to the copy of the Second Amended Complaint delivered to counsel  
2 for Microsoft, but denies that such copy was full and complete as it did not include, among other  
3 things, any of the drawings or figures. Microsoft further denies such copy was full and complete  
4 insofar as it did not include any material purportedly incorporated by reference therein. Microsoft  
5 denies that the '193 Patent was duly and lawfully issued. Microsoft further denies any and all  
6 remaining allegations of paragraph 8 of the Second Amended Complaint.

7 9. Microsoft admits that on its face the title page of U.S. Patent No. 5,940,504  
8 ("the '504 Patent") states that it was issued August 17, 1999 and is entitled "Licensing  
9 management system and method in which datagrams including an addressee of a licensee and  
10 indicative of use of a licensed product are sent from the licensee's site." Microsoft admits that a  
11 copy of the '504 Patent was attached to the copy of the Second Amended Complaint delivered to  
12 counsel for Microsoft. Microsoft denies that the '504 Patent was duly and lawfully issued.  
13 Microsoft further denies any and all remaining allegations of paragraph 9 of the Second Amended  
14 Complaint.

15 10. Microsoft admits that on its face the title page of U.S. Patent No. 5,920,861  
16 ("the '861 Patent") states that it was issued July 6, 1999, is entitled "Techniques for defining,  
17 using and manipulating rights management data structures," and lists "InterTrust Technologies  
18 Corp." as the assignee. Microsoft admits that a copy of the '861 Patent was attached to the copy  
19 of the Second Amended Complaint delivered to counsel for Microsoft, but denies that such copy  
20 was full and complete insofar as it did not include any material purportedly incorporated by  
21 reference therein. Microsoft denies that the '861 Patent was duly and lawfully issued. Microsoft  
22 further denies any and all remaining allegations of paragraph 10 of the Second Amended  
23 Complaint.

24 11. Microsoft repeats and reasserts its responses to paragraphs 1-7 of the  
25 Second Amended Complaint, as if fully restated herein.

26 12. Microsoft admits that the Second Amended Complaint purports to state a  
27 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
28 infringes the patents asserted against Microsoft in the Second Amended Complaint. Microsoft

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1 denies any and all remaining allegations of paragraph 12 of the Second Amended Complaint.  
2 13. Microsoft denies any and all allegations of paragraph 13 of the Second  
3 Amended Complaint.  
4 14. Microsoft denies any and all allegations of paragraph 14 of the Second  
5 Amended Complaint.  
6 15. Microsoft denies any and all allegations of paragraph 15 of the Second  
7 Amended Complaint.  
8 16. Microsoft denies any and all allegations of paragraph 16 of the Second  
9 Amended Complaint.  
10 17. Microsoft denies any and all allegations of paragraph 17 of the Second  
11 Amended Complaint.  
12 18. Microsoft repeats and reasserts its responses to paragraphs 1-6 and 8 of the  
13 Second Amended Complaint, as if fully restated herein.  
14 19. Microsoft admits that the Second Amended Complaint purports to state a  
15 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
16 infringes the patents asserted against Microsoft in the Second Amended Complaint. Microsoft  
17 denies any and all remaining allegations of paragraph 19 of the Second Amended Complaint.  
18 20. Microsoft denies any and all allegations of paragraph 20 of the Second  
19 Amended Complaint.  
20 21. Microsoft denies any and all allegations of paragraph 21 of the Second  
21 Amended Complaint.  
22 22. Microsoft denies any and all allegations of paragraph 22 of the Second  
23 Amended Complaint.  
24 23. Microsoft denies any and all allegations of paragraph 23 of the Second  
25 Amended Complaint.  
26 24. Microsoft denies any and all allegations of paragraph 24 of the Second  
27 Amended Complaint.

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MICROSOFT CORPORATION'S FIRST AMENDED ANSWER  
AND COUNTERCLAIMS, CASE NO. C 01-1640 SBA

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1                   25.    Microsoft repeats and reasserts its responses to paragraphs 1-6 and 9 of the  
2 Second Amended Complaint, as if fully restated herein.

3                   26.    Microsoft admits that the Second Amended Complaint purports to state a  
4 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
5 infringes the patents asserted against Microsoft in the Second Amended Complaint. Microsoft  
6 denies any and all remaining allegations of paragraph 26 of the Second Amended Complaint.

7                   27.    Microsoft denies any and all allegations of paragraph 27 of the Second  
8 Amended Complaint.

9                   28.    Microsoft denies any and all allegations of paragraph 28 of the Second  
10 Amended Complaint.

11                   29.    Microsoft denies any and all allegations of paragraph 29 of the Second  
12 Amended Complaint.

13                   30.    Microsoft denies any and all allegations of paragraph 30 of the Second  
14 Amended Complaint.

15                   31.    Microsoft denies any and all allegations of paragraph 31 of the Second  
16 Amended Complaint.

17                   32.    Microsoft repeats and reasserts its responses to paragraphs 1-6 and 10 of  
18 the Second Amended Complaint, as if fully restated herein.

19                   33.    Microsoft admits that the Second Amended Complaint purports to state a  
20 cause of action under 35 U.S.C. §§ 271 and 281. Microsoft denies that it has infringed or now  
21 infringes the patents asserted against Microsoft in the Second Amended Complaint. Microsoft  
22 denies any and all remaining allegations of paragraph 33 of the Second Amended Complaint.

23                   34.    Microsoft denies any and all allegations of paragraph 34 of the Second  
24 Amended Complaint.

25                   35.    Microsoft denies any and all allegations of paragraph 35 of the Second  
26 Amended Complaint.

27                   36.    Microsoft denies any and all allegations of paragraph 36 of the Second  
28 Amended Complaint.

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1 37. Microsoft denies any and all allegations of paragraph 37 of the Second  
2 Amended Complaint.

3 38. Microsoft denies any and all allegations of paragraph 38 of the Second  
4 Amended Complaint.

5 **AFFIRMATIVE AND OTHER DEFENSES**

6 Further answering the Second Amended Complaint, Microsoft asserts the  
7 following defenses. Microsoft reserves the right to amend its answer with additional defenses as  
8 further information is obtained.

9 **First Defense: Noninfringement of the Asserted Patents**

10 1. Microsoft has not infringed, contributed to the infringement of, or induced  
11 the infringement of U.S. Patent No. 6,185,683 B1 ("the '683 Patent"), U.S. Patent No. 6,253,193  
12 B1 ("the '193 Patent"), U.S. Patent No. 5,940,504 ("the '504 Patent") or U.S. Patent No.  
13 5,920,861 ("the '861 Patent"), and is not liable for infringement thereof.

14 2. Any and all Microsoft products or actions that are accused of infringement  
15 have substantial uses that do not infringe and therefore cannot induce or contribute to the  
16 infringement of the '683 Patent, the '193 Patent, the '504 Patent or the '861 Patent.

17 **Second Defense: Invalidity of the Asserted Patents**

18 3. On information and belief, the '683 Patent, the '193 Patent, the '504 Patent  
19 and the '861 Patent are invalid for failing to comply with the provisions of the Patent Laws, Title  
20 35 U.S.C., including without limitation one or more of 35 U.S.C. §§ 102, 103 and 112.

21 **Third Defense: Unavailability of Relief**

22 4. On information and belief, Plaintiff has failed to plead and meet the  
23 requirements of 35 U.S.C. § 271(b) and is not entitled to any alleged damages prior to providing  
24 any actual notice to Microsoft of the '683 Patent, the '193 Patent, the '504 Patent or the '861  
25 Patent.

26 **Fourth Defense: Unavailability of Relief**

27 5. On information and belief, Plaintiff has failed to plead and meet the  
28 requirements of 35 U.S.C. § 284 for enhanced damages and is not entitled to any damages prior to

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1 providing any actual notice to Microsoft of the '683 Patent, the '193 Patent, the '504 Patent,  
2 and/or the '861 Patent, and any alleged infringement thereof.

3 **Fifth Defense: Unavailability of Relief**

4 6. On information and belief, Plaintiff has failed to plead and meet the  
5 requirements of 35 U.S.C. § 287, and has otherwise failed to show that it is entitled to any  
6 damages.

7 **Sixth Defense: Prosecution History Estoppel**

8 7. Plaintiff's alleged causes of action for patent infringement are barred under  
9 the doctrine of prosecution history estoppel, and Plaintiff is estopped from claiming that the '683  
10 Patent, the '193 Patent, the '504 Patent, and/or the '861 Patent covers or includes any accused  
11 Microsoft product or method.

12 **Seventh Defense: Dedication to the Public**

13 8. Plaintiff has dedicated to the public all methods, apparatus, and products  
14 disclosed in the '683 Patent, the '193 Patent, the '504 Patent, and/or the '861 Patent, but not  
15 literally claimed therein, and is estopped from claiming infringement by any such public domain  
16 methods, apparatus, and products.

17 **Eighth Defense: Use/Manufacture By/For United States Government**

18 9. To the extent that any accused product has been used or manufactured by  
19 or for the United States, Plaintiff's claims and demands for relief are barred by 28 U.S.C. § 1498.

20 **Ninth Defense: License**

21 10. To the extent that any of Plaintiff's allegations of infringement are  
22 premised on the alleged use, sale, or offer for sale of products that were manufactured by or for a  
23 licensee of InterTrust and/or provided by or to Microsoft to or by a licensee of InterTrust, such  
24 allegations are barred pursuant to license.

25 **Tenth Defense: Acquiescence**

26 11. Plaintiff has acquiesced in at least those acts of Microsoft that are alleged  
27 to infringe the '861 Patent, the '683 Patent, and the '193 Patent.

Eleventh Defense: Laches

12. Plaintiff's claims for relief are barred, in whole or in part, by the equitable doctrine of laches.

Twelfth Defense: Inequitable Conduct

13. The '861 Patent claims are unenforceable due to inequitable conduct, including those acts and failures to act set forth in Microsoft's Counterclaim for Declaratory Judgment of Unenforceability of the '861 Patent, set forth below.

COUNTERCLAIMSCOUNT I - DECLARATORY  
JUDGMENT OF NONINFRINGEMENT

1. This action arises under the patent laws of the United States, Title 35 U.S.C. §§ 1, et seq. This Court has subject matter jurisdiction over this counterclaim under 28 U.S.C. §§ 1338, 2201, and 2202.

2. Microsoft Corporation ("Microsoft") is a Washington corporation with its principal place of business in Redmond, Washington.

3. Upon information and belief, Plaintiff/Counterclaim Defendant InterTrust Technologies Corporation ("InterTrust") is a Delaware corporation with its principal place of business in Santa Clara, California.

4. InterTrust purports to be the owner of U.S. Patent Nos. 6,185,683 B1 ("the '683 Patent"), 6,253,193 B1 ("the '193 Patent"), 5,940,504 ("the '504 Patent"), and 5,920,861 ("the '861 Patent").

5. InterTrust alleges that Microsoft has infringed the '683 Patent, the '193 Patent, the '504 Patent, and the '861 Patent.

6. No Microsoft product has infringed, either directly or indirectly, any claim of the '683 Patent, the '193 Patent, the '504 Patent, or the '861 Patent, and Microsoft is not liable for infringement thereof.

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1           7.     An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
2 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to the  
3 infringement or noninfringement of the '683 Patent, the '193 Patent, the '504 Patent, and/or the  
4 '861 Patent.

5                               **COUNT II - DECLARATORY**  
6                               **JUDGMENT OF INVALIDITY OF THE '683 PATENT**

7           8.     Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims, as if  
8 fully restated herein.

9           9.     The '683 Patent, and each claim thereof, is invalid for failing to comply  
10 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

11           10.    An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
12 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
13 whether the claims of the '683 Patent are valid or invalid.

14                               **COUNT III - DECLARATORY**  
15                               **JUDGMENT OF INVALIDITY OF THE '193 PATENT**

16           11.    Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if  
17 fully restated herein.

18           12.    The '193 Patent, and each claim thereof, is invalid for failing to comply  
19 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

20           13.    An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
21 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
22 whether the claims of the '193 Patent are valid or invalid.

23                               **COUNT IV - DECLARATORY**  
24                               **JUDGMENT OF INVALIDITY OF THE '504 PATENT**

25           14.    Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if  
26 fully restated herein.

27           15.    The '504 Patent, and each claim thereof, is invalid for failing to comply  
28 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

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1           16.     An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
2 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
3 whether the claims of the '504 Patent are valid or invalid.

4                               **COUNT V - DECLARATORY**  
5                               **JUDGMENT OF INVALIDITY OF THE '861 PATENT**

6           17.     Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims as if  
7 fully restated herein.

8           18.     The '861 Patent, and each claim thereof, is invalid for failing to comply  
9 with the provisions of the Patent Laws, including one or more of 35 U.S.C. §§ 102, 103 and 112.

10           19.     An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
11 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
12 whether the claims of the '861 Patent are valid or invalid.

13                               **COUNT VI - DECLARATORY JUDGMENT**  
14                               **OF UNENFORCEABILITY OF THE '861 PATENT**

15           20.     Microsoft repeats and realleges paragraphs 1-5 of its Counterclaims, as if  
16 fully restated herein.

17           21.     Claims 1-129 of the '861 Patent application (SN 08/805,804), and claims  
18 1-101 of the '861 Patent, were not and are not entitled to benefit of any application filing date  
19 prior to February 25, 1997, under 35 U.S.C. § 120 or otherwise.

20           22.     Exhibit A hereto is a reprint of an article entitled "Digibox: A Self-  
21 Protecting Container for Information Commerce." The article shown in Exhibit A (hereafter,  
22 "the Sibert article") was published in July 1995 in the Proceedings of the First USENIX  
23 Workshop on Electronic Commerce.

24           23.     On information and belief, the content of pages 2-14 of Exhibit A was  
25 presented at a public conference in the United States in July 1995.

26           24.     Exhibit B hereto is a copy of a page from an International Application  
27 published under the Patent Cooperation Treaty (PCT), bearing International Publication Number  
28 WO 96/27155.

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25. On information and belief, International Application WO 96/27155 has, at all times since its filing date, been owned and controlled by InterTrust or its predecessors in interest.

26. International Application WO 96/27155 (hereafter "the WO 96/27155 (PCT) publication") was published on September 6, 1996.

27. United States Patent No. 5,910,987 ("the '987 Patent") issued on June 8, 1999, from a continuation of an application filed on February 13, 1995.

28. The Sibert article is prior art to claims 1-129 of the '861 Patent application (SN 08/805,804), and claims 1-101 of the '861 Patent, under 35 U.S.C. §§ 102(b), 103.

29. The WO 96/27155 (PCT) publication is prior art to claims 1-129 of the '861 Patent application (SN 08/805,804), and claims 1-101 of the '861 Patent, under 35 U.S.C. §§ 102(a), 103.

30. The '987 Patent is prior art to claims 29-129 of the '861 Patent application (SN 08/805,804), and claims 1-101 of the '861 Patent, under 35 U.S.C. §§ 102(e), 103.

31. The Sibert article was material to the patentability of claim 1 of the '861 Patent application (SN 08/805,804).

32. The Sibert article was material to the patentability of claims 2-129 of the '861 Patent application (SN 08/805,804).

33. The WO 96/27155 (PCT) publication was material to the patentability of claim 1 of the '861 Patent application (SN 08/805,804).

34. The WO 96/27155 (PCT) publication was material to the patentability of claims 2-129 of the '861 Patent application (SN 08/805,804).

35. The '987 Patent was material to the patentability of claims 29-129 of the '861 Patent application (SN 08/805,804).

36. One or more of the '861 Patent applicants knew, while the '861 Patent application (SN 08/805,804) was pending, of the July 1995 publication of the Sibert article.

37. On information and belief, one or more of the '861 Patent applicants knew, while the '861 Patent application (SN 08/805,804) was pending, of the September 1996

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1 publication of the WO 96/27155 (PCT) publication.

2 38. One or more of the '861 Patent applicants knew, while the '861 Patent  
3 application (SN 08/805,804) was pending, of the June 8, 1999 issuance of the '987 patent.

4 39. On information and belief, one or more of the attorneys who prosecuted or  
5 assisted in prosecuting the '861 Patent application (SN 08/805,804) knew, while that application  
6 was pending, of the July 1995 publication of the Sibert article.

7 40. One or more of the attorneys who prosecuted or assisted in prosecuting the  
8 '861 Patent application (SN 08/805,804) knew, while that application was pending, of the  
9 September 1996 publication of the WO 96/27155 (PCT) publication.

10 41. One or more of the attorneys who prosecuted or assisted in prosecuting the  
11 '861 Patent application (SN 08/805,804) knew, while that application was pending, of the June 8,  
12 1999 issuance of the '987 patent.

13 42. The applicants for the '861 Patent did not cite the Sibert article, the WO  
14 96/27155 (PCT) publication, or the '987 Patent to the Patent Office as prior art to any of claims 1-  
15 129 of the '861 Patent application (SN 08/805,804).

16 43. The applicants for the '861 Patent did not cite to the Patent Office as prior  
17 art to any of claims 1-129 of the '861 Patent application (SN 08/805,804) any reference having  
18 the same or substantially the same disclosure as the Sibert article, the WO 96/27155 (PCT)  
19 publication, or the '987 Patent.

20 44. None of the Sibert article, the WO 96/27155 (PCT) publication, or the '987  
21 Patent is merely cumulative over any reference cited as prior art during the prosecution of the  
22 '861 Patent application (SN 08/805,804).

23 45. On information and belief, one or more of the '861 Patent applicants  
24 believed, during pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the  
25 Sibert article disclosed an embodiment of claim 1 of the '861 Patent application (SN 08/805,804).

26 46. On information and belief, one or more of the '861 Patent applicants  
27 believed, during pendency of claim 1 of the '861 Patent application (SN 08/805,804), that the  
28 WO 96/27155 (PCT) publication disclosed an embodiment of claim 1 of the '861 Patent

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1 application (SN 08/805,804).

2 47. On information and belief, one or more of the '861 Patent applicants  
3 believed, while the '861 Patent application (SN 08/805,804) was pending, that the Sibert article  
4 was material to the patentability of claims 1-129 of the '861 Patent application (SN 08/805,804),  
5 but, with deceptive intent, failed to disclose that reference as prior art to the Patent Office.

6 48. On information and belief, one or more of the '861 Patent applicants  
7 believed, while the '861 Patent application (SN 08/805,804) was pending, that the WO 96/27155  
8 (PCT) publication was material to the patentability of claims 1-129 of the '861 Patent application  
9 (SN 08/805,804), but, with deceptive intent, failed to disclose that reference as prior art to the  
10 Patent Office.

11 49. On information and belief, one or more of the '861 Patent applicants  
12 believed, while the '861 Patent application (SN 08/805,804) was pending, that the '987 Patent  
13 was material to the patentability of claims 29-129 of the '861 Patent application (SN 08/805,804),  
14 but, with deceptive intent, failed to disclose that reference as prior art to the Patent Office.

15 50. The '861 Patent is unenforceable due to the inequitable conduct of the '861  
16 Patent applicants before the Patent and Trademark Office in connection with the '861 Patent  
17 application (SN 08/805,804).

18 51. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
19 exists between Microsoft, on the one hand, and InterTrust, on the other hand, with respect to  
20 whether the claims of the '861 Patent are enforceable.

21 **COUNT VII - INFRINGEMENT**  
22 **OF U.S. PATENT NO. 6,049,671**

23 52. Microsoft repeats and realleges paragraphs 2-3 of its Counterclaims, as if  
24 fully restated herein.

25 53. This Court has exclusive subject matter jurisdiction over Microsoft's cause  
26 of action for patent infringement under Title 28, United States Code, Sections 1331 and 1338, and  
27 under the patent laws of the United States, Title 35 of the United States Code.

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54. U.S. Patent No. 6,049,671 ("the '671 Patent") issued to Microsoft Corporation as the assignee of Benjamin W. Slivka and Jeffrey S. Webber on April 11, 2000.

55. A true copy of the '671 Patent is attached as Exhibit C hereto, and is incorporated herein by reference.

56. Microsoft owns all right, title and interest in the '671 Patent.

57. InterTrust has had actual notice of the '671 Patent.

58. InterTrust has infringed one or more claims of the '671 Patent, in violation of at least 35 U.S.C. § 271(a, b, c).

59. InterTrust's infringement of the '671 Patent has caused and will continue to cause Microsoft damage, including irreparable harm for which it has no adequate remedy at law.

#### **COUNT VIII - INFRINGEMENT OF U.S. PATENT NO. 6,256,668**

60. Microsoft repeats and realleges paragraphs 2-3 and 51 of its Counterclaims, as if fully restated herein.

61. U.S. Patent No. 6,256,668 B1 ("the '668 Patent") issued to Microsoft Corporation as the assignee of Benjamin W. Slivka and Jeffrey S. Webber on July 3, 2001.

62. A true copy of the '668 Patent is attached as Exhibit D hereto, and is incorporated herein by reference.

63. Microsoft owns all right, title and interest in the '668 Patent.

64. InterTrust has had actual notice of the '668 Patent.

65. InterTrust has infringed one or more claims of the '668 Patent, in violation of at least 35 U.S.C. § 271(a, b, c).

66. InterTrust's infringement of the '668 Patent has caused and will continue to cause Microsoft damage, including irreparable harm for which it has no adequate remedy at law.

#### **PRAYER FOR RELIEF**

WHEREFORE, Microsoft prays for the following relief:

A. The Court enter judgment against InterTrust on, and dismiss with

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1 prejudice, any and all claims of the Second Amended Complaint;

2 B. The Court enter judgment declaring that Microsoft has not infringed,  
3 contributed to infringement of, or induced infringement of the '683 Patent;

4 C. The Court enter judgment declaring that Microsoft has not infringed,  
5 contributed to infringement of, or induced infringement of the '193 Patent;

6 D. The Court enter judgment declaring that Microsoft has not infringed,  
7 contributed to infringement of, or induced infringement of the '504 Patent;

8 E. The Court enter judgment declaring that Microsoft has not infringed,  
9 contributed to infringement of, or induced infringement of the '861 Patent;

10 F. The Court enter judgment declaring that the '683 Patent is invalid;

11 G. The Court enter judgment declaring that the '193 Patent is invalid;

12 H. The Court enter judgment declaring that the '504 Patent is invalid;

13 I. The Court enter judgment declaring that the '861 Patent is invalid;

14 J. The Court enter judgment that the '861 Patent is unenforceable due to  
15 inequitable conduct;

16 K. The Court enter judgment that InterTrust has infringed the '671 patent;

17 L. The Court enter judgment that InterTrust has infringed the '668 patent;

18 M. A permanent injunction prohibiting InterTrust, its officers, agents, servants,  
19 employees, and all persons in active concert or participation with them from infringing the '671  
20 and '668 Patents;

21 N. An award against InterTrust of damages and attorney fees, pursuant to the  
22 provisions of 35 U.S.C §§ 284, 285.

23 O. An award to Microsoft of prejudgment interest and the costs of this action.

24 P. The Court award to Microsoft its reasonable costs and attorneys' fees; and

25 Q. The Court grant to Microsoft such other and further relief as may be  
26 deemed just and appropriate.

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ORRICK  
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JURY DEMAND

Pursuant to Fed. R. Civ. P. 38(b), Defendant Microsoft Corporation demands a trial by jury.

DATED: September 17, 2001

By: Mark R. Weinstein

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